Tafas v. Dudas et al
Doc. 258 Att. 11

EXHIBIT 7

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How the New PTO Regulations Will Impact Your Practice

George Mason University School of Law

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Overall Goals

- To improve the rules of the patent application process for the 400,000+ applications received each year.
- To ensure that the public is informed of the scope of patent protection as early as possible.
- To provide options concerning the speed of prosecution and the scope of an application.

Topics

- Accelerated Examination (AE): 12 Months to Decision
- Information Disclosure Statement (IDS) NPR
- Deferred Examination

Accelerated Examination (AE) -- 12 Months to Decision

Changes to Practice for Petitions in Patent Applications To Make Special and for Accelerated Examination, 71 *Fed. Reg.* 36323 (June 26, 2006) (notice of changes in USPTO practice)

Notice available on the USPTO web site at: http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.pdf

The effective date is August 25, 2006.

Members of the public may submit electronic comments to: MPEPFeedback@uspto.gov

AE -- 12 Months to Decision

OBJECTIVES

- To provide an option allowing patent applicants to receive a final decision within 12 months from the filing date of the application.

- To allow applicants to choose, in certain situations, which applications to advance for examination.

AE -- 12 Months to Decision: Requirements

An applicant who chooses the 12-month final decision option must assist the examiner in expeditiously arriving at a final disposition by:

- *initially* providing additional information with the petition for accelerated examination; and
- *throughout* the 12-month period, complying with revised prosecution procedures.

AE -- 12 Months to Decision: Requirements

- The application, petition, and required fees must be filed electronically via EFS or EFS-Web.
- The application must contain:

  3 or fewer independent claims; and

  20 or fewer total claims.

- The claims must be directed to a single invention.
- The application must not contain any multiple dependent claims.

AE -- 12 Months to Decision: Applicants' Responsibilities

- File a petition (form PTO/SB/28) requesting accelerated examination and agreeing to comply with the rules.

- Submit an appropriate examination support document (ESD).

AE -- 12 Months to Decision: Applicants' Responsibilities

- No opt-out! Applicant may not voluntarily withdraw from AE program.
- Abide by shortened periods for reply:
  - One-month (or 30 days) SSP for any action, other than a final rejection or allowance.
  - No extensions of time under § 1.136(a) permitted, but extensions are available under § 1.136(b).

AE -- 12 Months to Decision: Examiners' Responsibilities

- The accelerated examination support document will be considered.
- A complete prior art search will be conducted.
- A telephone interview will be held, unless an interview is deemed unlikely to overcome the rejection.
- A patentability conference will be conducted in the USPTO prior to mailing any first Office action on the merits in order to ensure the viability of the rejection(s).
- A patentability conference will be conducted in the USPTO before mailing any final Office action.

Information Disclosure Statement NPR

Changes to Information Disclosure Statement Requirements and Other Related Matters, 71 *Fed. Reg.* 38808 (July 10, 2006) (notice of proposed rule making)

NPR available on the USPTO web site at: http://www.uspto.gov/web/offices/com/sol/notices/71fr38808.pdf

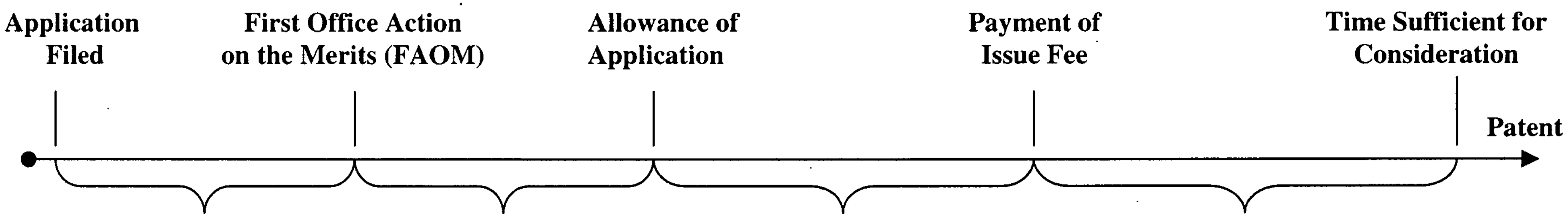
To be ensured of consideration, public comments must be received by September 8, 2006, and may be submitted electronically to AB95.comments@uspto.gov.

Information Disclosure Statement NPR: Objectives

- To provide the examiner with the IDS before the first Office action on the merits.
- To allow the examiner to focus on the most pertinent art.
- To provide the examiner with meaningful information when large documents, foreign language documents, or many documents are submitted.
- To help applicants avoid having to submit an IDS for documents served on them by third parties.

Information Disclosure Statement NPR: Highlights

Application Prosecution Timeline and Corresponding IDS Requirements


Application Filed
First Office Action on the Merits (FAOM)
Allowance of Application
Payment of Issue Fee
Time Sufficient for Consideration
Patent

First Period

Up to 20 citations permitted w/o any *explanation* req'd.

- *Explanations* req'd for: each ref. >25 pages, or in non-English language, or for all refs when more than 20

Second Period

- *Explanation*, and
- *Non-cumulative description*

Third Period

- Timeliness cert., and
- *Patentability Justification* which includes: *Explanation*, *Non-cumulative description*, and either:
  (A) Patentability reasons for unamended claims; or
  (B)(1) Statement of unpatentable claims,
  (B)(2) Amendment, and
  (B)(3) Patentability reasons for amended claim(s)

Fourth Period

- Timeliness cert.;
- *Patentability Justification* which includes:
  Explanation,
  Non-cumulative description,
  Statement of unpatentable claims,
  Amendment, and
  Patentability reasons for amended claim(s); and
- Petition to w/d from allowance

Information Disclosure Statement NPR: Highlights

Compliance with the "explanation" requirement need not require an extensive submission. Example:

Facts:

- Patent A teaches a rotary pump, as element 32 in Figure 3; and
- Claim 1 of the application being examined recites a rotary pump (as taught in Patent A).

Explanation:

- Patent A teaches a rotary pump as element 32 in Figure 3, which correlates to the recitation of a rotary pump in claim 1.

Information Disclosure Statement NPR: Highlights

Safe Harbor

The proposed rule addresses the bar's concern that the "additional disclosure" requirements, when triggered, may expose practitioners to inequitable conduct charges.

A safe harbor applies to a party attempting to comply with the "additional disclosure" requirements of § 1.98 who has made a reasonable inquiry into the relationship of the submitted documents to the claims, has acted in good faith, and has a reasonable basis for the statements made.

Deferred Examination

Basic Concepts Under Consideration

- Applicant may choose to defer examination for a certain number of years from U.S. filing date, as well as payment of certain fees.
- Applicant may not defer the basic filing fee or any requirements concerning 18-month publication.
- Applicant may activate examination at any time.
- Third party may activate examination after publication.

Deferred Examination

Proposed Example

Filing fee paid→

Application published at 18 months→

Examination deferred for 3 years from filing (no third party activation) →

Examination deferred 2 additional years (third party activation permitted)→

Remaining fees paid & examination begins

Deferred Examination

Expected Benefits

- Non-deferred cases will be examined more quickly.
- The upfront cost of filing will be reduced.
- Delayed payment of certain fees will allow additional time for applicant to consider the commercial viability of inventions before further expenditure of funds.
- The Office can devote its time and resources to applications deemed more pressing by applicants.
- Pendency will be reduced because some applications will not proceed to examination.

Deferred Examination

Issues to be Resolved

1. How may a third party activate an application?
2. What should be the term of the deferral?
3. What should be the impact on Patent Term Adjustment?
4. Should provisions be made for intervening or provisional rights for third parties during the deferral period?
5. Should applicants who defer be required to consent to protests filed by third parties after publication?

Questions?